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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,663	12/04/2006	Shigenori Fujikawa	1248-1030PUS1	9919
2292 7590 07/23/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER SCHIFFMAN, BENJAMIN A				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
07/23/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

**Application No.**

10/555,663

**Applicant(s)**

FUJIKAWA ET AL.

**Examiner**

BENJAMIN SCHIFFMAN

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2010.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-6 and 8-18 is/are pending in the application.  
4a) Of the above claim(s) 10-18 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 3-6, 8 and 9 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 04 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Paper No(s)/Mail Date \_\_\_\_\_  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The papers submitted on 28 January 2010, amending claim 1 and canceling claim 19, are acknowledged.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 January 2010 has been entered.

### ***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
4. The following title is suggested: METHOD OF PRODUCING A NANOMATERIAL.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 3, 8, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cuisin et al. (*Fabrication of three-dimensional photonic structures with submicrometer resolution by x-ray lithography*) in view of Fujikawa et al. (*Surface Fabrication of Interconnected Hollow Spheres of nm-Thick Titania Shell*) and Wen et al. (*Organic/Inorganic Hybrid Network Materials by the Sol-Gel Approach*).

9. Regarding claim 1, Cuisin discloses a method of forming a submicrometer, i.e. nanometer, material (**see abstract**) with the steps of forming a mold by a lithographic method on a substrate, in this case the mold is formed in a layer of PMMA, i.e. a resist, deposited upon

Si/SiC/W substrate (see pp. 3506-7, section II); forming a metal oxide on the PMMA layer, i.e. forming an organic/metal oxide composite layer; and finally removing the PMMA layer, to form a metal oxide submicrometer structure (see p. 3508, section IV).

10. Cuisin does not appear to explicitly disclose that the oxide film is formed by bringing a metal compound capable of reaction with hydroxyl of carboxyl groups present into contact with a forming surface and hydrolyzing the metal compound to obtain the oxide. Although Cuisin does describe that the oxide is formed by a sol-gel process, which is a process of bringing a liquid precursor containing a metal compound into contact with a surface and hydrolyzing the metal compound to form a metal oxide.

11. However, Fujikawa discloses a method of forming a nanostructure (see title) wherein oxide thin film is formed on latex beads forming an organic/metal oxide film the latex having a carboxylated surface and the titania film is formed on the latex surface through a sol-gel process (see p. 1134).

12. At the time of invention, it would have been *prima facie* obvious to one of ordinary skill in the art to modify the method of Cuisin to include the carboxylated surface of Fujikawa, because the sol-gel technique is a known method of applying metal oxide thin films and would obtain predictable results.

13. Additionally, modified Cuisin does not appear to explicitly disclose activating the mold by an oxygen plasma treatment or ozone oxidation treatment. Furthermore, one of ordinary skill in the art would recognize that the latex of Fujikawa must have been chemically modified to form the carboxyl groups; as unmodified latex does not have carboxyl functional groups.

14. However, Wen discloses that the adhesion between the sol and a plastic substrate, such as PMMA, in a sol-gel process (**see title/abstract**), can be improved by treating the substrate with oxygen plasma (**see p. 1679 col. 2**).

15. At the time of invention, it would have been *prima facie* obvious to one of ordinary skill in the art to modify the method of modified Cuisin to include the plasma treatment of Wen, as this would increase the adhesion between the oxide layer and the substrate and allow for better handling before the removal of the plastic substrate/mold. Further, such plasma treatment would result in an increase in the number of carboxyl and hydroxyl functional groups in the substrate polymer and thus result in a stronger bond between the substrate and the oxide layer.

16. Regarding claim 3, Cuisin discloses that the PMMA mold, i.e. the organic portion of the organic/metal oxide composite, is removed (**see pp. 3508, section IV**).

17. Regarding claim 8, Cuisin discloses that the mold is formed in PMMA, i.e. an organic compound (**see pp. 3506-7, section II**).

18. Regarding claim 9, Cuisin discloses that the mold of PMMA is removed by calcination, i.e. baking (**see p. 3508, section IV**).

19. Claim 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cuisin et al. (*Fabrication of three-dimensional photonic structures with submicrometer resolution by x-ray lithography*) in view of Fujikawa et al. (*Surface Fabrication of Interconnected Hollow Spheres of nm-Thick Titania Shell*) and Wen et al. (*Organic/Inorganic Hybrid Network Materials by the Sol-Gel Approach*) as applied to claim 1, and further in view of Li et al. (*A High-Rate, High-Capacity, Nanostructured Sn-Based Anode Prepared Using Sol-Gel Template Synthesis*).

20. Cuisin discloses a method of forming nanostructure as described in the 102(b) rejections of claim 1 and 3 above.

21. Cuisin does not appear to explicitly disclose a step of removing the substrate from the mold/organic portion of the organic/metal oxide composite.

22. However, Li discloses a method of making nanostructures (**see abstract**) with the step of removing the metal oxide nanostructure from the substrate (**see p. A165 col. 1**).

23. At the time of invention, it would have been *prima facie* obvious to one of ordinary skill in the art to modify the method of Cuisin to include the substrate removal step of Li, in order to inspect the formed nanostructure with a TEM (**see p. A165 col. 1**).

24. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cuisin et al. (*Fabrication of three-dimensional photonic structures with submicrometer resolution by x-ray lithography*) in view of Fujikawa et al. (*Surface Fabrication of Interconnected Hollow Spheres of nm-Thick Titania Shell*) and Wen et al. (*Organic/Inorganic Hybrid Network Materials by the Sol-Gel Approach*) as applied to claim 1, and further in view of Kenausis et al. (*Poly(l-lysine)-g-Poly(ethylene glycol) Layers on Metal Oxide Surfaces: Attachment Mechanism and Effects of Polymer Architecture on Resistance to Protein Adsorption*).

25. Cuisin discloses a method of producing a nanostructure as discussed in the above 102(b) rejection of claim 1.

26. Cuisin does not appear to expressly disclose covering at least a portion of nanostructure, or the mold/organic portion.

27. However, Kenausis discloses a polymer coating for a metal oxide surface (**see abstract**).

28. At the time of invention, it would have been *prima facie* obvious to one of ordinary skill in the art to modify the method of Cuisin to include the coating of Kenausis, in order to convert the oxide from a strongly interactive surface to a noninteractive surface in applications such as biomaterials (**see abstract**).

### ***Response to Arguments***

29. Applicant's arguments with respect to claims 1, 3-6, 8 and 9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN SCHIFFMAN whose telephone number is (571) 270-7626. The examiner can normally be reached on Monday through Thursday from 9AM until 4PM.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHRISTINA JOHNSON can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BENJAMIN SCHIFFMAN/  
Examiner, Art Unit 1791

/Christina Johnson/

Supervisory Patent Examiner, Art Unit 1791